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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
	:	Examiner: P. Lee
SEBASTIEN A. JEAN, et al.)	
	:	Group Art Unit: 2152
Appeal No.: 2008-1660)	
	:	
Application No.: 09/853,767)	
	:	
Filed: May 14, 2001)	
	:	
For: NETWORK DEVICE)	July 25, 2008
MIMIC SUPPORT)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION AND REHEARING

Pursuant to 37 C.F.R. § 41.52, Appellants, Sebastien A. Jean, et al., respectfully request rehearing of the Board's Decision On Appeal dated May 28, 2008 in the above-identified application. Applicants respectfully believe that a number of points were misapprehended and/or overlooked by the Board, and therefore request reconsideration and reversal of the rejections for at least the reasons discussed below.

I. Introduction

The Board's Decision affirmed the Examiner's rejections of Claims 1 to 40 under 35 U.S.C. § 103(a), primarily over U.S. Publication No. 2002/0080391 (Sugiura) and U.S. Patent No. 6,816,270 (Cooper).

Applicants' invention relates to a method for mimicking network devices. With particular reference to independent Claim 1, the method is performed in a computing device having first and second network interface cards, the first network interface card

connecting the computing device to an external network and the second network interface card connecting the computing device to a local network. The method includes receiving an incoming message from a client network device residing on the external network, the incoming message being addressed to a network address of a target network device residing on the local network. The method further includes determining if an application module residing in the computing device is configured to process a functionality requested by the incoming message. In addition, the method includes redirecting the incoming message to the application module in the case that the application module is configured to process the functionality, and passing the incoming message through the local network to the target network device residing on the local network in the case that the application module is not configured to process the functionality.

Applicants respectfully submit that the Board's decision to affirm is based upon a misapprehension and/or overlooking of several aspects of the claimed invention and this cited art. For the purposes of this Request, Claim 1 includes two key features, namely that:

- The incoming message is addressed to a target device (e.g., a printer), but is received by the computing device that is carrying-out the mimicking method; and
- The computing device that is carrying-out the mimicking method makes a determination as to its capability, and in particular determines if it has an application module configured to process the requested functionality.

Through these and other features, the present invention provides upgraded functionality on behalf of target devices, while remaining transparent to both client and target. These features distinguish the claimed invention fundamentally from the applied art, which at best teaches the very conventional technique of having a print server receive a message that is addressed to it (Sugiura), and the equally unremarkable technique of determining the capabilities of a printer (Cooper).

II. The Board’s Decision Overlooks And/Or Misapprehends The Significance Of The Fact That In The Claimed Invention The Incoming Message Is Addressed To A Target Device But Received By The Computing Device That Is Carrying-Out The Mimicking Method.

The Board took the position that Sugiura’s client terminal device 33 “addresses” the designated printer, and that since Sugiura’s print server 23 receives a message from the terminal device, Sugiura performs the claimed receiving step. Specifically, the Board asserts that “[t]he artisan would have well understood in our view that the addressability...includes the print server as explained by Appellants, but it also includes the addressability of the designated printer itself to the extent claimed.” Decision On Appeal, p. 8. More specifically, the Board takes the position that “[s]ignificantly, from the point of view of Sugiura’s terminal device 33, it is addressing the specified printer”. Id.

Applicants respectfully submit that the Board’s focus on the terminal device’s “point of view” overlooks a key feature of Applicants’ claim language. Applicants’ claim language requires a message addressed to the network address of the target device. Thus, Sugiura’s terminal device’s “point of view” is simply inadequate to meet the claimed receiving step, since the claim is written in terms of the incoming

message and the target device to which it is addressed. Sugiura does not show an incoming message that is addressed to a target device, and hence does not disclose this feature.

Indeed, the logical foundations of the Examiner's analysis on this point are unsound. The Decision On Appeal states that "the artisan also may have considered the claimed target network device as the print server in [Sugiura]". Decision On Appeal, p. 8. But, if Sugiura's print server is considered to be a target device, there is nothing in Sugiura to correspond to the claimed computing device for receiving messages addressed to the network address of the target. Thus, there is no device to isolate the server/target on a local network, or to receive messages directed to the network address of the server/target in order to perform functionality on its behalf.

Moreover, transmitting a message directly to a network address of Sugiura's print server as a target would contravene the purpose of Sugiura, which is to bypass firewalls that block messages directly addressed to target devices. See Sugiura, paragraphs [0012], [0044] and [0045]; See also MPEP § 2141.02 ("A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.").

III. The Board's Decision Overlooks And/Or Misapprehends The Significance Of The Fact That In The Claimed Invention The Computing Device That Is Carrying-Out The Mimicking Method Makes A Determination As To Its Capability.

The Board asserts that determining capabilities of a printer (Cooper) is a "logical complement" to determining abilities of the application modules in the claimed computing device. More specifically, the Board states that "the capability of determining

must be either in the target device (a printer) or in an application module (the software structures and the like).” Decision on Appeal, p. 9. The Board adds that “the overall effect upon the operability of the [sic,] switching capabilities of Cooper and the claims analytically comparable within 35 U.S.C. § 103.” Decision On Appeal, p.10.

Applicants respectfully submit that the Board overlooked or failed to consider several points which would emphasize that the determination made in Cooper is not a logical complement to the claimed determination.

First, the Board failed to consider Cooper’s clear teaching that Cooper is intended to “maintain device exploitation of hardware features”, which Cooper discloses as advantageous. Cooper, Column 6, lines 58 to 59, Column 8, lines 4 to 5. If Cooper’s object is to exploit all available hardware, then it is contrary to the teachings of Cooper to suggest that an artisan following Cooper would instead defer to software. See also MPEP § 2141.02 (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”).

Moreover, the Board failed to consider that Cooper’s determination and the claimed determination are not the only two determinations possible. One alternative outcome would be determining whether another connected printer could process the functionality. Another alternative outcome is dropping the message when no devices are able to process the functionality. Accordingly, Cooper’s determination and the claimed determination are not “logical complements”.

The Board also failed to consider the superior advantages obtained by the Applicants’ design. In particular, Applicants’ computing device is able to perform a requested functionality even if a target device can also perform the functionality. Thus,

functionality for target devices can be upgraded simply by upgrading application modules in the computing device. In contrast, since Cooper defaults to printer hardware in order to maintain hardware device exploitation, Cooper's hardware will perform the functionality if able, even if Cooper's hardware is old or obsolete.

According to the Decision on Appeal, "the actual physical location in which the determination is made is not considered pertinent or a basis of patentability since it is not recited to be in any specific module other than the computing device generally". Decision on Appeal, p. 10. The Board's statement that certain claim language (apparently, "in the computing device") is not considered pertinent or a basis of patentability is contrary to established patent law. MPEP § 2143.03 ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Moreover, Applicants submit that the physical location of the application modules, i.e., in the computing device, is both pertinent and important, and emphasizes the differences from Cooper. In this regard, Applicants do not merely recite a "computing device generally". Applicants recite a specific computing device having first and second network interface cards, the first network interface card connecting the computing device to an external network and the second network interface card connecting the computing device to a local network.

In the context of this computing device, the importance of determining the abilities of application modules residing in the computing device can not be discounted, since it allows the computing device to determine whether it includes an application module which can process a functionality, and allows the computing device to redirect messages to the application module before the message reaches the target device. Thus,

not only is the physical location of the application modules pertinent to the patentability of the invention, but also is important to providing the advantages gained by the invention.

Conclusion

In view of the above, Applicants submit that the Board variously misapprehended the applied art, and overlooked or misapprehended key claim language. Accordingly, Applicants respectfully request reversal of the rejection of Claims 1 to 40.

No fee is believed to be due in connection with the filing of this paper. Nevertheless, the Commissioner is authorized to charge Deposit Account No. 06-1205, should any fee be deemed due.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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